

## **REMARKS/ARGUMENTS**

Claims 1, 3-4, 7-9, 11-12, 14-29, 37, 39 and 41-50 remain in this application. Claims 36 and 38 are cancelled without prejudice or disclaimer. New claims 42-50 are based on claim 7 and claims depending therefrom; the new claims differ by being limited to a promoter having a nucleotide sequence which hybridizes only to the complement of nucleotides 1-1532 of SEQ ID NO:2 under stringent conditions.

On June 1, 2007, the undersigned contacted Examiner Zhou to clarify inconsistencies between the Office Action Summary and the acknowledgement of allowable claims on page 5 of the Action. The following provides the substance of the interview. The Examiner clarified that claims 1, 3-4, 8-9, 11-12, 14-15, 17, 19, 21, 23, 25, 27, 37, 39 and 41 are allowed. Their listing as rejected on the Office Action Summary was incorrect.

### **Specification Objections**

Page 5, line 6, of the specification is amended to add the term “or” before the phrase “SEQ ID NO:2” as suggested by the Examiner.

Page 28, line 21, of the specification is amended to capitalize “HYBOND” and to accompany it by the generic terminology as requested by the Examiner. In addition page 26, line 14, of the specification is amended to capitalize “GIGAPACK.” Applicant submits that the term is already accompanied by the generic terminology “packaging extract.” Furthermore, page 28, line 13, of the specification is amended to capitalize “TRIZOL” and to accompany it by the generic terminology.

Withdrawal of the specification objections is respectfully requested.

### **Claim Rejection under 35 U.S.C. § 112**

Claims 36 and 38 were rejected under 35 U.S.C. 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant traverses. In order to further prosecution of this application, however, claims 36 and 38 are cancelled without prejudice or disclaimer.

Claims 7, 16, 18, 20, 22, 24, 26 and 28-29 were rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. The Examiner alleged that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Applicant traverses the Examiner's rejection, *inter alia*, for the following reasons.

The Examiner acknowledged the specification describes that 1-1532 of SEQ ID NO:2 has regulatory activity such as promoter activity, but states that the specification does not describe any sequence, such as the complementary sequence of nucleotides of 1-1532 of SEQ ID NO:2, which hybridizes to 1-1532 of SEQ ID NO:2, also has promoter activity.

Claim 7 is directed to an isolated DNA molecule comprising a nucleotide sequence that hybridizes to nucleotides 1-1532 of SEQ ID NO:2 or a complement thereof under specific conditions, and that the nucleotide sequence is a promoter. Applicant notes that the claimed sequence is novel and unobvious in view of the prior art, the subject matter of the claim is supported by at least one sequence within the scope of the claimed genus, and that there has been a reduction to practice of the disclosed species. As a result, this claim format should be considered acceptable by the USPTO.

In support of this argument, Applicant notes with reference to pages 36-37 of “Example 9: Hybridization” of the “Synopsis of Application of Written Description Guidelines” (January 16, 2003; [www.uspto.gov/web/menu/written.pdf](http://www.uspto.gov/web/menu/written.pdf)), that for a sequence that is novel and unobvious in view of the prior art, where a single species is disclosed that is within the scope of the claimed genus, and where there is reduction to practice of the disclosed species, it is stated that:

“...a person of skill in the art would not expect substantial variation among species encompassed within the scope of the claims because the highly stringent hybridization conditions set forth in the claim yield structurally similar DNAs. Thus a representative number of species is disclosed, since highly stringent hybridization conditions in combination with the coding function of DNA and the level of skill and knowledge in the art are required to determine the applicant was in possession of the claimed invention.

**Conclusion:** The claimed invention is adequately described.”

Claims of a scope similar to that of claim 7, and with the same written description, are routinely allowed by the USPTO.

Applicant submits that a person of skill in the art would be readily able to identify a DNA molecule that hybridizes to nucleotides 1-1532 of SEQ ID NO:2 or its complement under the hybridization conditions defined in claim 7. Furthermore, as the sequence defined in claim 7 is free of any cited art, and as the sequence is defined in combination with the function of the sequence (i.e., it is a promoter), Applicant submits that the claim is adequately described by a representative number of species within the broadly claimed genus.

By having possession of a nucleotide comprising 1-1532 of SEQ ID NO:2 and a fully supported description that the nucleotide sequence works as a promoter, as well as a description of the hybridization conditions, Applicant submits that a person of skill in the relevant art would readily

recognize that at the time the application was filed, the inventor had possession of the claimed invention.

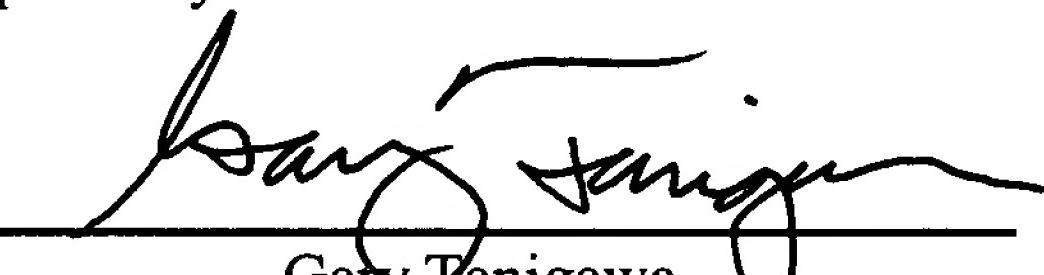
Applicant therefore submits that the subject matter of claim 7 and claims 16, 18, 20, 22, 24, 26, 28 and 29 dependent thereon, are adequately defined by the present specification, and fully comply with the written description requirement. Furthermore, Applicant notes that this objection has been previously raised and subsequently withdrawn in view of his amendments and arguments of record.

Applicant requests the withdrawal of the rejection under 35 U.S.C. 112, first paragraph, of claims 7, 16, 18, 20, 22, 24, 26 and 28-29.

It is respectfully submitted that the above-identified application is in condition for allowance and favorable reconsideration and prompt allowance of these claims are respectfully requested. Should the Examiner believe that anything further is desirable in order to place the application in better condition for allowance, the Examiner is invited to contact the Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted

By



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